



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/519,321	05/09/2005	Yoram Oren	0-04-204	9122
7590 Kevin D McCarthy Roach Brown McCarthy & Gruber 1620 Liberty Building Buffalo, NY 14202			EXAMINER HU, HENRY S	
			ART UNIT 1796	PAPER NUMBER
			MAIL DATE 02/03/2009	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/519,321

Applicant(s)

OREN ET AL.

Examiner

HENRY S. HU

Art Unit

1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Request for Status of 1-12-2009.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-37 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 May 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

1. It is noted that USPTO has received **Request for Status** filed on January 12, 2009. **No pre-amendment or IDS is applied.** The examiner accepts Applicants' **seven drawing sheets with Figures 1-6.** **Attention:** Applicants need to send in **Brief Description** for the drawing figures (Figures 1-6) according to MPEP. **Claims 1-37 with five independent claims (Claims 1, 32, 33, 35 and 36) are now pending.** An action follows.

DETAILED ACTION

Election/Restrictions

2. Restriction to one of the following inventions is required under 35 U.S.C. 121: It is noted that **five independent claims are marked with an underline.**

I. **Claims 1-31 and 37, drawn to a six-step (a-f) process of making ion exchange membrane.**

II **Claim 32, drawn to the use of ion exchange membranes, comprising a polymeric matrix and ion exchange particles, wherein said particles are generally ordered in power sources.**

III. **Claim 33, drawn to different use of ion exchange or proton or hydroxyl or ion conducting membranes, comprising a polymeric matrix and ion exchange or conducting particles or ion exchange or proton or hydroxyl or ion conducting domains or any combination of**

Art Unit: 1796

ion exchange, proton, hydroxide and ion conductivity, wherein said membranes are used in power sources.

IV **Claim 35**, drawn to **a type of ion exchange membranes**, comprising a polymeric matrix and ion exchange or conducting particles or domains or any combination of ion exchange, proton, hydroxide and ion conductivity,, wherein said particles or domains are generally ordered, for use in power sources.

V. **Claim 36**, drawn to **different type ion exchange membranes**, comprising a polymeric matrix and ion exchange particles or domains, wherein said particles or domains are generally ordered, for use in fuel cells.

3. The inventions are distinct, each from the others because of the following reasons:

Inventions I, II /III and IV/V is related to process of making a product (Group I), process of using a product (Groups II and III) and the product (Groups IV and V). The inventions are distinct each other if either or both of the following can be shown: (1) that the process as claimed can make or use other and materially different product or (2) that the product as claimed can be made or used by another and materially different process.

In the instant case, the “making” process as claimed in Group I can be applied to make other and materially different type membrane other than using ion (cation or anion) exchange particles, as long as the particles is compatible with the polymer matrix. For instance, chelating compound is available. In a very close examination, each group is distinct from each other due

Art Unit: 1796

to the existence of other functional group, in different order or in different sequence.

Therefore the scope of the claims, i.e., the metes and boundaries are distinct.

4. **Attention: The use claim (Claim 32 in Group II and Claim 33 in Group III) is improper according to MPEP** since steps and/or sequence of using are NOT disclosed.

Therefore, **rewriting of Claims 32 and 33 is necessary.**

5. Because these inventions are distinct for the reasons given above and the search required for each group is not required for other groups have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

6. It is noted that no phone call was made to Attorney **Kevin D. McCarthy (registration # 35,278, tel: 716 812-0400)** by the examiner due to the complexity on multiple (five) independent claims along with multiple (five) distinct groups. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

7. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Conclusion

8. Any inquiry concerning this communication or earlier communication from the examiner should be directed to **Dr. Henry S. Hu whose telephone number is (571) 272-1103**. The examiner can be reached on Monday through Friday from 9:00 AM –5:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Vasu Jagannathan, can be reached on (571) 272-1119. The **fax** number for the organization where this application or proceeding is assigned is **(571) 273-8300** for all regular communications. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Peter D. Mulcahy/
Primary Examiner, Art Unit 1796

/Henry S. Hu/
Examiner, Art Unit 1796

January 30, 2009